JUL 11 2003 JC42 PATENT & TRADEMARK OFFICE

Election w/ Ex(4)/#8
J 7.17.03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Marion J. Bussemakers *et al.*
Appl. No. 09/996,953
Filed: November 30, 2001
For: **Nucleic Acid Molecules Comprising the Promoter for PCA3^{DD3}, A New Prostate Antigen, and Uses Thereof**

Confirmation No. 2414
Art Unit: 1642
Examiner: Minh-Tam Davis
Atty. Docket: 1619.0100000/SRL/CMB

Reply To Restriction Requirement

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated **February 11, 2003**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I , represented by claims 1-2. Further, Applicants provisionally elect the sequences of Claim 1. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

MPEP 803 (August 2001, page 800-4) sets out one of the criteria for a restriction as: "There must be a serious burden on the Examiner if restriction is required....". In the present case, Applicants respectfully assert that the search of more than one restriction group does not impose a serious burden upon the Examiner.

Applicants respectfully request that claims of Groups I and II be examined together. Claims of Group I, represented by claims 1-2, are drawn to a promoter region of the polynucleotide of SEQ ID NO: 1, the claims of Group II (claims 3-6 and 11-14) are

drawn to a vector comprising a promoter region of the polynucleotide of SEQ ID NO: 1 and a host cell comprising said vector. These inventions are linked by the presence of the promoter of claim 1. The polynucleotide of SEQ ID NO: 1 is used to express sequences in a vector, when that vector is present in a host cell. Examining these claims together, therefore, is in no way an undue burden on the Examiner. Invariably, a search for the invention of Group I as set forth would provide the same art as a search for the patentability of Group II. It is therefore respectfully requested that these groups be joined for the purpose of examination on the merits.

Furthermore, Group III (claim 7) is drawn to a method of modulating the transcription of a heterologous sequence in a prostate cell, Group IV (claim 8) to a method of modulating the expression of a transcript in a prostate cancer cell, Group V (claims 9-10) to a method for identifying an agent which modulates an expression of a transcript in a prostate cell, and Groups VI and VII (claim 15) drawn to methods of diagnosing prostate cancer or a predisposition to prostate cancer. All of these methods are based upon the activity of a specific nucleotide region of SEQ ID NO: 1. Therefore, a search of the claims of any one of these Groups is likely to cover the same material as a search concerning the claims the other groups. Further, the DNA sequence in question in Groups III-VII is the polynucleotide claimed in both groups I and II, and therefore any searches of Groups III-VII would cover the same material as a search of Groups I and II.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional

extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Nancy J. Leith

Nancy J. Leith
Agent for Applicants
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Date: July 11, 2003

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- I WILL REVIEW ALL

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SKGF rev 1/26/01 mac; 4/22/03 svb

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Art Unit 1642

Commissioner for Patents
PO Box 1450
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Re: U.S. Utility Patent Application
Appl. No. 09/996,953; Filed: November 30, 2001
For: **Nucleic Acid Molecules Comprising the Promoter for PCA3^{DD3}, A New Prostate Antigen, and Uses Thereof**
Inventors: Bussemakers *et al.*
Our Ref: 1619.0100000/SRL/CMB

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Fee Transmittal PT/SB/17;
2. Petition for Extension of Time Under 37 C.F.R. 1.136(a);
3. Reply to Restriction Requirement;
4. PTO-2038 Credit Card Payment Form for $725.00 to cover four month extension of time; and
5. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Nancy J. Leith

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SRL/NJL:cpn
Enclosures

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